

Appl. No. 10/003,900
Atty. Docket No. 8762
Amdt. dated March 17, 2004
Reply to Final Office Action of January 30, 2004
Customer No. 27752

REMARKS

No amendments to the Claims are being presented in this response to the Office Action dated January 30, 2004. Claims 1-20 remain in this Application and are presented for the Examiner's review in light of the following remarks.

Rejection Under 35 U.S.C. §103

Claims 1-20 have been finally rejected under 35 U.S.C. §103(a) over McGuire, et al., U.S. Patent No. 5,965,235. Arguments made previously with respect to this rejection will not be repeated for the sake of brevity. Applicants respectfully request the Examiner to consider the following new arguments with respect to this rejection:

The Examiner states the *McGuire* reference "teaches the adhesive coating composition having a thickness less than the height of the non-adherent protrusions and preferably about 0.001 inch (0.025 mm) thick and even more preferably between about 0.0005 inch (0.013 mm) and 0.002 inch (0.051 mm)." The Examiner continues by stating, "However, McGuire et al. fails to teach the specific ranges for the thickness of the adhesive coating composition as recited in claims 1 and 2 of the present invention." Applicants concur. Continuing, the Examiner states that, "The thickness of the adhesive coating composition would be readily determined through routine experimentation.... There is no indication in McGuire et al. that the thickness of the adhesive coating composition cannot be in the range from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm)."

Applicants are at a loss to understand how an adhesive coating having a thickness ranging from about 0.00001 inch to about 0.0002 inch is suggested by the *McGuire* reference. Applicants' claimed adhesive thickness is at least one order of magnitude less than the thickness disclosed in the *McGuire* reference. The claimed adhesive, applied to a substrate at a thickness that is at least one order of magnitude less than that of the cited prior art and provides sufficient adhesive properties to form a bond to most common materials that is sufficiently strong so as to survive handling without failure (p. 8, ll. 21-24), is significant difference over the cited prior art. Applicants respectfully submit that the prior art is so deficient that there is no motivation to make what might otherwise appear to be obvious changes. See *In re Dillon*, 919 F.2d 688, 16 U.S.P.Q.2d 1897 (Fed.Cir. 1990) (*en banc*), cert. denied. 500 U.S. 904 (1991) (citing *Albrecht*, 514 F.2d at 1396, 8185 U.S.P.Q. at 590; *In re Stelmiski*, 444 F.2d at 581, 170 U.S.P.Q. 343 (C.C.P.A. 1971); *In re Rushig*, 343 F.2d 965, 145 U.S.P.Q. 274 (C.C.P.A. 1965)). It is hard to fathom how an adhesive applied to a substrate of a thickness that is at least one order of magnitude less than the range cited in the prior art can be a "discovery of an optimum or workable range," as the Examiner suggests.

Appl. No. 10/003,900
Atty. Docket No. 8762
Amdt. dated March 17, 2004
Reply to Final Office Action of January 30, 2004
Customer No. 27752

In response to Applicants' Amendment filed on November 4, 2003, the Examiner states that the Declaration filed under 37 C.F.R. §1.132 is "merely drawn to Applicants' opinion of the prior art cited by the Examiner. There is no showing of unexpected results." Applicants are at a loss to understand the Examiner's position. Applicants' Declaration states, "[T]he instant Application is distinguishable from McGuire because the bending resistance of the substrate becomes the limiting factor in the adherence of a food storage wrap to rough or irregular surfaces when thin adhesive layers are used. The instant Applications has found that storage wrap materials having adhesive layers thinner than those specified in McGuire can be produced by [using] a thin layer of adhesive (0.00001 inch to 0.0002 inch)...." The submitted Declaration also states that, "[S]torage wrap materials generally require a thick adhesive layer to provide sufficient flow into the voids and irregularities of the surface to which the storage wrap material is attached; . . . the application of a thin layer of adhesive (0.00001 inch to 0.0002 inch) to a substrate will not generally provide sufficient flow into the voids and irregularities of the surface to which the storage wrap material is attached." Further, Applicants state the benefit of the application of a thin layer of adhesive in that, "[S]uch thin adhesive layers (0.00001 inch to 0.0002 inch) as claimed in the instant Application are desirable because they provide significant cost savings and processing benefits due to the need for less adhesive."

Thus, Applicants respectfully believe the examples provided in the submitted Declaration are of probative value because they do involve a comparison of Applicants' invention with the closest applied prior art (*See In re De Blawe*, 222 U.S.P.Q. 191 (Fed.Cir. 1984) and *In re Fenn*, 208 U.S.P.Q. 470 (C.C.P.A. 1981).

While it is true that it is well settled that a *prima facie* case of obviousness may be rebutted "where the results of optimizing a variable, which was known to be result effective, are unexpectedly good," Applicants respectfully submit that an adhesive applied to a web substrate at a thickness that is at least one order of magnitude less than the thickness of an adhesive applied to a substrate in the art cited by the Examiner, is not the mere optimization of a variable. *See In re Boesch*, 617 F.2d 272, 205 U.S.P.Q. 215 (Fed.Cir. 1980). Therefore, an adhesive coating composition having a thickness ranging from about 0.00001 inch to 0.0002 inch applied to a sheet material having a thickness ranging from about 0.0001 inch to 0.001 inch, as claimed by Applicants, is both novel and unobvious over the art cited by the Examiner in the instant Application.

In light of Applicants' Declaration submitted previously under 37 C.F.R. §1.132 and the entirety of Applicants' arguments in the instant Application, Applicants respectfully submit that the *McGuire* reference cited by the Examiner fails to disclose, teach, suggest, or render obvious every recited feature of Applicants' independent Claims 1, 16, and 20. Therefore, Applicants respectfully

Appl. No. 10/003,900
Atty. Docket No. 8762
Amdt. dated March 17, 2004
Reply to Final Office Action of January 30, 2004
Customer No. 27752

request withdrawal of the Examiner's 35 U.S.C. §103(a) rejection with respect to Applicants' Claims 1, 16, and 20.

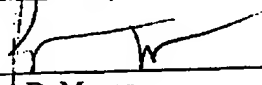
Because Claims 2-15 and 17-19 all depend directly or indirectly from Applicants' independent Claims 1 or 16, they contain all of their respective limitations. For this reason, Applicants submit that the arguments made above concerning the allowability of Claims 1 and 16 are equally applicable to the rejection of Claims 2-15 and 17-19 under 35 U.S.C. §103(a). Applicants therefore request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejection to Claims 2-15 and 17-19 accordingly.

Conclusion

Based on the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

This response is timely filed pursuant to the provisions of 37 C.F.R. §1.8 and M.P.E.P. §512, and no fee is believed due. However, if any additional charges are due, the Examiner is hereby authorized to deduct such charge from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,
HAMILTON, ET AL.



Peter D. Meyer
Attorney for Applicants
Registration No. 47,792
(513) 634-9359

March 17, 2004
Customer No. 27752